

133816-1

## REMARKS

### Pending and Withdrawn Claims

In the Office Action Summary, claims 1-8, 10, 11, 13-26, and 29-32 are listed as pending, and no claims are listed as withdrawn from consideration. Applicants respectfully request correction to reflect that claims 1-8, 10, 11, and 13-36 are pending, and claims 27, 28, and 33-36 are withdrawn from consideration.

### Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-8, 10-11, 13-26, and 29-32 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,878,782 to Merfeld et al. ("Merfeld"). Applicants respectfully traverse this rejection.

On 9/9/05, Applicants submitted a declaration under 37 C.F.R. § 1.132 by Gary W. Yeager ("Yeager declaration"). That declaration included an unequivocal statement that declarant Yeager conceived the portions of Merfeld relied on by the Examiner in his rejection. In the latest office action, the Examiner states,

The Declaration under 37 CFR 1.132 filed 9/09/05 is insufficient to overcome the rejection of claims 1-8, 10-11, 13-26 and 29-32 based upon a specific reference applied under 35 U.S.C. 103 as set forth in the last Office action because: fails to set forth facts related to the invention.

Because reference is a joint Patent Published Application to Applicant and another, then an unequivocal declaration under 35 CFR 1.132 must be filed by S that he conceived or invented the subject matter disclosed in the application publication and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). However, said declaration is insufficient to show the relevant portions of the reference originated with or were obtained from applicant in that neither relevant dates nor conception have been detailed. MPEP 716.10.

11/10/02 Office Action, page 3, first and second full paragraphs (emphasis added).

Applicants respectfully assert that the Yeager declaration is sufficient to overcome the rejection. Specifically, while citing the proper authority governing this

133816-1

issue, the Examiner apparently has misinterpreted that authority to improperly require that the declaration "set forth facts related to the invention". MPEP 716.10 provides two ways to overcome a rejection based on subject matter "disclosed but not claimed in a patent application filed jointly by S and another". MPEP 716.10. Applicant's first option is to file an affidavit or declaration under 37 C.F.R. § 1.131 showing prior invention. *Id.* In that instance, Applicant must provide factual evidence. *See, e.g.,* MPEP 715.07. Applicant's second option is for the Applicant to file "an unequivocal declaration . . . under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application". MPEP 716.10. "An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982)." *Id.* Note that in *DeBaun*, the Court of Customs and Patent Appeals held that, "[o]n the basis of the record here, which includes appellant's unequivocal declaration that he conceived anything in the '678 patent disclosure which suggests the invention claimed in his present application, that question has been satisfactorily answered." *DeBaun*, 214 USPQ at 936. Note also that the Court characterized the reference in *DeBaun*'s declaration to specific factual evidence as unnecessary. *DeBaun*, 214 USPQ at 934, footnote 5. Thus, an applicant relying on a Rule 132 declaration need not provide factual evidence. Both MPEP 716.10 and *DeBaun* make clear that he need only provide an unequivocal declaration that he conceived the subject matter relied on by the examiner.

Here, declarant Yeager has made such an unequivocal declaration in paragraph number 7 of his declaration:

7. I conceived the portions of paragraphs [0081] and [0084] of U.S. Patent Application Publication No. 2002/0169256 of Merfeld et al. relied on by the Examiner in the claim rejections of the 6/23/04 office action and the 8/29/05 advisory action.

Yeager declaration, page 2. Thus, Applicants respectfully submit that the Yeager declaration is sufficient to overcome the rejection over Merfeld. Accordingly, Merfeld is not available as a reference under 35 U.S.C. § 102, and Applicants respectfully request

133816-1

the reconsideration and withdrawal of the rejection of claims 1-8, 10-11, 13-26, and 29-32 under 35 U.S.C. § 103(a) over Merfeld.

Nonstatutory Double Patenting Rejections

Claims 1-8, 10-11, 13-26, and 29-32 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 22, and 28-35 of U.S. Patent No. 6,878,782. Applicants are submitting herewith a terminal disclaimer in compliance with 37 CFR § 1.321(c) to overcome the rejection.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-1131 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP  
Applicants' Attorneys

By: J. Michael Buchanan  
J. Michael Buchanan  
Registration No. 44,571

Date: December 14, 2005  
Customer No.: 23413  
Telephone: (860) 286-2929